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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	367.39429X00	8071

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EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,190

Applicant(s)

KINNUNEN ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Wherein, the specification does not include content concerning 'a look-up table' in the instant application. Appropriate action is required.
3. Claim 2 recites the limitations "the multimedia message". There is insufficient antecedent basis for these limitations in the claim.
4. Claim 9 recites the limitation "the volume" in line 2 on page 7. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 10 recites the limitation "the color" in line 5 on page 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application Publication No. EP 788065 by Jennings in view of U.S. Patent Number 5,838,685 by Hochman.

Regarding claim 1, Jennings discloses a communications device (Figure 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (page 2, lines 20-23, page 2, line 58 - page 3, line 2, page 3, line 57 - page, line 1, and page 5, lines 40-41) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; page 3, lines 19-38).

Jennings does not disclose a message header holding the conditions under which the message may be opened by the device of the recipient.

Hochman discloses a method and apparatus for the transmission of data files (see Abstract). Wherein Hochman further discloses means for selecting conditions under which the message may be opened by a device of a recipient and means for storing said component (e.g. facsimile image, conventional text, audio or video file) as a message together with a message header holding the conditions under which the message may be opened by the device of the recipient (see Figure 3; column 4, lines 16-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Jennings to include a message header holding the conditions under which the message may be opened by the device of the recipient as taught by Hochman. One of ordinary skill in the art would have been lead to make such a modification since header contains conditions under how the message may be opened, e.g. utilizing the header information to process the message having configured the receiving device to properly receive and view the transmitted message.

Regarding claim 2, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses in which the message header further contains information descriptive of a content of a multimedia message (page 3, line 44-47).

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses the message includes a plurality of components and associated presentation files (see Figure 2; page 3, lines 44-56).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses in which at least one component is a multimedia file (page 3, lines 44-50).

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for creating a presentation file associated with said component, said file being stored with said message (page 3, lines 51-56).

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Jennings further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (page 6, lines 9-15; page 6, lines 54-55).

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Jennings further discloses the presentation file inherently contains parameters relating to a volume of a component comprising an audio recording (page 2, lines 9-19; page 4, line 33 – page 6, line 8).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein

Art Unit: 2645

Jennings further discloses the presentation file inherently contains parameters relating to a color and font of a component comprising a text string (page 2, lines 9-19; page 4, lines 30-32).

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; page 6, lines 9-11).

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses means for inherently formatting the message as an email (page 2, lines 34-52; page 3, lines 19-32).

Regarding claim 13, a device as claimed claim 1 mentioned above, wherein Jennings further discloses a wireless network interface means (see Figure 1; page 3, lines 32-38).

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view of Hochman, as applied to claim 1, in further view of U.S. Patent No. 6,421,707 by Miller et al, hereinafter Miller.

Regarding claim 3, a device as claimed in claim 1 mentioned above, wherein Jennings does not disclose a look-up table wherein the table contains entries of locations from which components are selectable.

Miller discloses a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting conditions under which the message may be opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said

Art Unit: 2645

component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412). Miller further discloses entries of locations from which components are selectable (Figure 4a, 401; Figure 4b: E:\temp\wdsatt.txt, E:\temp\WDS-1-14-98.ppt, C:\1386\Ringout.wav -> these components were selected from different locations on the user's system; column 4, lines 29-40). Wherein, a look-up table is inherently discloses that contains entries of locations from which components are selectable (e.g. E:\temp\wdsatt.txt, E:\temp\WDS-1-14-98.ppt, C:\1386\Ringout.wav).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the device of Jennings in view of Hochman to include a look-up table as taught by Miller, to assist the user in sending a recipient a component in a message. One of ordinary skill in the art would have been lead to make such a modification since a look-up table would allow the user to easily search for entries of locations from which components are selectable rather than using the inherent method of attaching a file to search for the particular component on the user's system.

Regarding claim 4, a device as mentioned in claim 3 above mentioned above, wherein Miller further discloses at least one of the locations is the memory of the communication device (column 4, lines 29-40).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view Hochman, as applied to claim 1, and in further view of U.S. Patent No. 6,421,707 by Miller.

Regarding claim 14, a device as claimed in claim 1 mentioned above, wherein Jennings further discloses the device is a workstation (page 3, lines 19-32).

Art Unit: 2645

Jennings in view of Hochman do not disclose the device is a radio telephone.

Miller discloses a communications device (Figure 1, 120) including a messaging user interface (Figure 1, 122; column 3, lines 6-15), the interface including means for selecting a component for inclusion in a message (as shown in Figure 1, 150; column 2, lines 65-66), means for selecting the conditions under which the message may be opened (Figure 1, 110; column 2, line 66 – column 3: line 5) and means for storing said component as a message (column 3, lines 16-26) and the message is associated with a message header holding message delivery conditions (see Figure 4g, 412). Miller further discloses a communications device or cellular/PCS telephone (Figure 3, 301) using GSM as a carrier network (Figure 3; column 3, lines 59-61) including a wireless network interface (Figure 4n, 412).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Jennings in view of Hochman to include the communication device being a radio telephone as taught by the mobile handset of Miller to provide a handset with an improved user interface. One of ordinary skill in the art would have been lead to make such a modification since the communication device being a cellular/PCS telephone can utilize a wireless network interface to send a multimedia message to an equipped device such as a fax to display the message.

Response to Arguments

10. Applicant's arguments, see Amendment, filed November 17, 2004, with respect to the rejection(s) of claim(s) 1-14 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all 103(a) rejections above.

Art Unit: 2645

11. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Thus the claim limitations in the examined claims above that employ phrases of type: “FOR” doing something, e.g. ‘means for selecting a component’, etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted above have the structure and functions of performing the claimed limitations.

12. Accordingly, this action is **NON-FINAL**.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,175,743 by Alperovich et al teach a method for encapsulating header information associated with a SMS message; the header information includes message delivery conditions

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Art Unit: 2645

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302.


The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

December 13, 2004


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600